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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/677,122

10/01/2003

Kozo Odamura

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27572

7590

06/02/2006

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EXAMINER

SPEER, TIMOTHY M

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/677,122

Applicant(s)

ODAMURA ET AL.

Examiner

Timothy M. Speer

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1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 7-13, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masafumi in view of Patel (USPN 5,639,447).

Masafumi teaches a thermal transfer material and printing methods utilizing the thermal transfer material. The thermal transfer material comprises a first colored layer comprising a pigment and a second colored layer comprising a pearlescent pigment (abstract), meeting the limitations of claim 10. The thermal transfer material may further include a release layer (instant claim 12) and a backside layer (claim 17) (abstract, for instance). Regarding claim 9, use of the thermal transfer results in a coated substrate as recited in claim 9. Similarly, since the printing method of Masafumi is thermal transfer, as recited in dependent claims 7 and 8, it anticipates the dependent claims (1 and 2) from which these claims depend. With respect to claims 3 and 4, Masafumi teaches that the pearlescent pigment may comprise mica coated with a metal oxide, such as titania or iron oxide. Therefore, it is the Examiner's position that the present claims are anticipated by Masafumi.

Masafumi fails to teach the inclusion of a brightening agent. Patel teaches that is conventional in the coating arts to add brightening agents to coating composition comprising colored pigments, including pearlescent pigments, in order to brighten the resultant coating (col.

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2, lines 4-11 and col. 4, lines 29-30, for instance). Therefore, it would have been obvious to one having ordinary skill in the art to employ a brightening agent in the article of Masafumi, in order to provide a coating having excellent optical characteristics, such as brightness, since Patel teaches the desirability of such combinations. Therefore, it is the Examiner's position that the present claims are prima facie obvious over the applied combination of references.

3. Claims 6, 14-16 and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masafumi in view of Patel, as applied above, and further in view of Ohnishi (USPN 5,928,989).

Masafumi was discussed above and fails to teach applying a thermal transfer layer. Ohnishi teaches that in thermal transfer printing process, protective layers may be used in order to impart weather resistance, chemical resistance and solvent resistance to the transferred color layers (abstract, for example). Therefore, it would have been obvious to one having ordinary skill in the art to employ a protective layer in the printing method and thermal transfer article of Masafumi, in order to impart weather resistance, chemical resistance and solvent resistance to the transferred color layers, as taught by Ohnishi. Therefore, it is the Examiner's position that the present claims are prima facie obvious in view of the applied combination of prior art references.

Response to Arguments

4. Applicant's arguments filed 03/07/06 have been fully considered but they are not persuasive. Applicant argues that the applied prior art references do not constitute analogous art and, accordingly, are not properly combinable. This argument has been considered, but is not persuasive, for reasons set forth hereinafter.

5. In response to applicant's argument that the Patel is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art references are concerned with achieving maximum brightness from compositions containing pearlescent pigments. Accordingly, Patel forms a proper basis for rejection of the claimed invention, since Patel is concerned with the problem with which applicant is concerned regarding the brightening agent.
6. In light of the above, applicant's arguments have been considered, but are not found to be persuasive.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Speer whose telephone number is 571-272-8385. The examiner can normally be reached on M-Th, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Timothy M. Speer



JENNIFER C. MCNEIL
SUPERVISORY PATENT EXAMINER
5/30/66